



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SA

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/467,221	12/20/99	OKAUE	T 450100-4465.

MM91/0721

WILLIAM S FROMMER ESQ  
FROMMER LAWRENCE & HAUG LLP  
745 FIFTH AVENUE  
NEW YORK NY 10151

EXAMINER

FELTEN, D

ART UNIT

PAPER NUMBER

2876

DATE MAILED:

07/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/467,221

Applicant(s)

Okaue et al

Examiner

Daniel Felten

Group Art Unit

2876

☒ Responsive to communication(s) filed on Dec 20, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 19-24 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 19-24 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## DETAILED ACTION

- 1 1. Receipt of the Preliminary Amendment filed April 17, 2000 canceling claims 1-18 and  
2 adding claims 19-24.

### *Specification*

- 3  
4  
5 2. The abstract of the disclosure is objected to because the abstract should be a single  
6 paragraph. Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 102*

- 7  
8  
9  
10 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form  
11 the basis for the rejections under this section made in this Office action:

12 A person shall be entitled to a patent unless --

13 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use  
14 or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 15 3. Claims 19, 20, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by  
16 Robinson et al (US 5,428,579).

1        Re claim 19, Robinson et al discloses a memory card 110 for storing data transmitted  
2        Is from an external apparatus 101 (see Robinson et al fig.2, col. 1, lines 26-33; and col. 5, lines  
3        1-8; and col. 5, line 62 to col. 6, line 2 );

4        a flash memory (EPROMs) for storing the data transmitted from the external apparatus  
5        101 (see col. 5, line 66-68);

6        a switch 116 settable to a state which inhibits writing data into the flash memory  
7        (EPROMs) (see col. 6, lines 15-21);

8        an interface 112 for transmitting data to and receiving data from the external  
9        apparatus 101 (see col. 5, lines 62-63); and

10       control means (EPROM) for controlling said memory card in accordance with an  
11       instruction transmitted from said external apparatus (see Robinson et al. col 6, lines 15-22), the  
12       control means sending to the external apparatus 101 via the interface 112 the state of the switch  
13       116 in response to an instruction transmitted thereto via the interface 112 from the external  
14       apparatus 116 (see Robinson et al, col. 5, lines 56 to col. 6, line 2).

15  
16       Re claim 20 and 23, a memory card, wherein the interface includes nine connectors at  
17       least one of which transmits and receives data (see Robinson et al, fig. 3, col. 6, line 27-34).

18  
19       Re claim 22, a system comprising a memory card 110 and an external apparatus 101,  
20       wherein data is communicated therebetween,

1 the memory card 101 comprising:

2 a flash memory (EPROMs) for storing the data transmitted from the external  
3 apparatus 101 (see Robinson et al, col. 5, line 66-68);  
4

5 a switch 116 settable to a state which inhibits writing data into said flash memory  
6 (see Robinson et al, col. 6, line 64 to col. 7, line 7);

7 an interface 116 for transmitting data to and receiving data from the external  
8 apparatus 101 (see Robinson et al, col. 5, lines 62-63); and

9 control means (EPROM) for controlling the memory card in accordance with an  
10 instruction transmitted from the external apparatus 101 (see Robinson et al, col, lines 15-22), the  
11 control means (EPROMs) sending to the external apparatus 101 via the interface 112 the state of  
12 the switch 116 in response to an instruction transmitted thereto via said interface from the  
13 external apparatus 116 (see col. 5, lines 56 to col. 6, line 2);

14 and the external apparatus comprising:

15 a controller (EPROM) for writing data to or erasing data from the flash memory of  
16 the memory card (see col. 5, lines 56-61); the controller transmitting an instruction to the  
17 memory card via the interface to determine whether a data writing operation to the flash memory  
18 of the memory card is inhibited (see col. 7, line 57 to col. 8 line 5)  
19  
20

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al (US 5,428,579) in view of Jigour et al (US 5,815,426). The teachings of Robinson et al have been discussed above.

Robinson et al fails to explicitly teach or disclose a memory card wherein the data is received from and transmitted to the external apparatus in serial form.

Jigour et al discloses/teaches memory cards (see Jigour et al fig. 23) wherein the data can be received from and transmitted to the external apparatus in parallel and/or serial form (see col. 10 lines 38-53). Serial form of transmitting/receiving data is conventional in the art for cheaply transferring digital information one bit at a time in the order the values were stored during the initial entry. It would have therefore been obvious for an artisan of ordinary skill at the time of the invention of Robinson et al under normal engineering practices to employ a device to receive data from and transmitted data to the external apparatus in serial form, as

1 Is disclosed/taught in Jigour et al., in order to maintain low cost of data transfer between the  
2 memory card and the external device. Thus such a modification would have been an obvious  
3 expedient to one of ordinary skill in the art.

4  
5  
6 Conclusion

7  
8 6. The prior art made of record and not relied upon is considered pertinent to applicant's  
9 disclosure: Robinson et al (US 5,388,248) discloses a flash memory card including plural flash  
10 memories and circuitry for selectively outputting ready/busy signals in different operating modes  
11 Elbert (US 5,267,218) discloses nonvolatile memory card with a single power supply a input Baji  
12 et al (US 5,163,111) discloses customized personal terminal device 10 Nagata et al (US  
13 5,796,092) discloses and IC card and IC card system m 7. Any inquiry concerning this  
14 communication or earlier communications from the examiner should be directed to Daniel S.  
15 Felten whose telephone number is (703) 305-0724.

16 The examiner can normally be reached between the hours of 7:30AM to 6:00PM  
17 Monday, Tuesday, Thursday, and Friday.

18 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
19 supervisor, Don Hajec, can be reached on (703) 308-7045. The fax phone number for this Group  
20 is (703)308-7382 or (703) 308-7722.

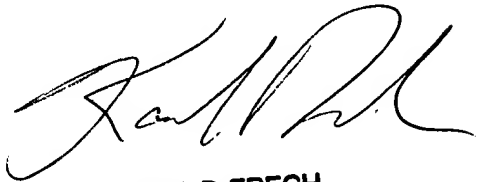
1 Communications via Internet e-mail regarding this application, other than those under 35  
2 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
3 addressed to [daniel.felten@uspto.gov].

4 All Internet e-mail communications will be made of record in the application file. PTO  
5 employees do not engage in Internet communications where there exists a possibility that  
6 sensitive information could be identified or exchanged unless the record includes a properly  
7 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
8 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
9 Trademark on February 25, 1997 at 1 195 OG 89.

10 Any inquiry of a general nature or relating to the status of this application or proceeding  
11 should be directed to the Group receptionist whose telephone number is (703) 308-0956.

12  
13 DSF

14 June 15, 2000

  
KARL D. FRECH  
PRIMARY EXAMINER  
6/19/00